

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 4 and 6-8 are pending, with Claims 3 and 5 cancelled and Claims 7-8 added by way of the present amendment.

In the Official Action, Claims 3-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakamura et al. (U.S. Patent 5,740,168, hereinafter Nakamura) in view of Adachi (U.S. Patent 6,084,884). Claims 4 and 6 are amended to more clearly describe and distinctly claim Applicants' invention. Support for amended Claims 4 and 6 as well as new Claims 7 and 8 is found in Applicants' originally filed specification. No new matter is added.

Applicants note the present application is the subject of a Petition to Make Special. Thus, Applicants request expedited handling of this application per MPEP § 708.02(VIII).

Applicants acknowledge with appreciation the personal interview between the Examiner, the Examiner's supervisor, and Applicants' representatives on January 19, 2006 regarding co-pending application 10/796,092. During the interview, the Examiners acknowledged that amending the claims in co-pending application 10/796,092 to clarify that the completion message is sent from the mobile to a base station or a base station controlling apparatus appears to overcome the art of record in co-pending application 10/796,092 (i.e., Nakamura and Adachi, both also applied as a basis of rejection in the present application). For the reasons discussed during the interview and repeated below, Applicants submit that the claims now pending in the present application also distinguish over the art of record. As discussed during the interview, independent Claims 4 and 6 are amended to to clarify that the completion message is sent from the mobile to a base station as disclosed in Applicants' originally filed specification.<sup>1</sup> No new matter is added.

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<sup>1</sup> Specification, page 26, line 23 through page 29, line 29.

Briefly recapitulating, independent Claims 4 and 6-8 are directed to corresponding communications systems and method. In particular, Claim 7 is directed to a radio communication method of a base station used for a radio communication system employing CDMA (Code Division Multiple Access) for radio access with a plurality of mobile stations and a base station controlling apparatus, the base station being one of a plurality of base stations, the base station controlling apparatus controlling the plurality of base stations and the plurality of mobile stations. The radio communication method includes: transmitting code information by message from the base station controlling apparatus to one of the plurality of mobile stations, the code information for switching from a first code being used to a second code; transmitting timing information by message to the one of the plurality of mobile stations, the timing information indicating a timing of switching from the first code to the second code; switching at the base station a spreading code from the first code to the second code in accordance with the timing information; and receiving a code switching complete message from the one of the plurality of mobile stations, the code switching complete message indicating a completion of switching from the first code to the second code at the one of the plurality of mobile stations. The invention ensures accurate synchronization of the base station and mobile.<sup>2</sup>

Nakamura describes a method for code switching, including the transmission of a timing signal from a base station to a mobile station.<sup>3</sup> However, Nakamura does not disclose or suggest “receiving a code switching complete message from the one of the plurality of mobile stations, the code switching complete message indicating a completion of switching from the first code to the second code at the one of the plurality of mobile stations.” As noted during the interview and as acknowledged by the Examiners, Nakamura only discloses

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<sup>2</sup> Specification, paragraphs 121-128.

<sup>3</sup> Nakamura, Figures 420B and 25.

registering the completion of switching from one code to another code in an internal (not external) controller.<sup>4</sup>

Additionally, because Nakamura is explicit that an indication of switching completion is merely stored internally and is not sent from the mobile to the base station, Applicants submit that Nakamura teaches away from Applicants' claimed feature of receiving a completion message from the one of a plurality of mobile stations to indicate completion of a step of switching from a first code to a second code at the one of the plurality of mobile stations. Thus, Applicants submit that any combination that modifies the internal registration of Nakamura to include the receiving a completion message from a mobile is improper.

Furthermore, Nakamura does not disclose or suggest Applicants' claimed base station controlling apparatus. That is, Nakamura only discloses a base station and a mobile station. Nakamura does not disclose or suggest a base station controlling apparatus separate from a plurality of base stations, as recited in Applicants' claims.

Applicants have considered the Adachi reference and submit Adachi does not cure the deficiencies of Nakamura.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of

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<sup>4</sup> Nakamura column 7, lines 4-15.

obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both Nakamura and Adachi fail to disclose all the features of recited in Applicants' claimed invention.

Also during the interview, U.S. Patent No. 6,148,209 to Hamalainen et al. (hereinafter Hamalainen) was discussed. While Hamalainen is not of record in the present application, Hamalainen has been cited in Applicants' copending application 10/796,090. During the interview, Applicants' representatives noted that neither Hamalainen nor Nakamura disclose or suggest sending a code switching message from a mobile to a base station or a base station controlling apparatus. As noted above and during the interview, Nakamura only discloses reporting the completion of switching from one code to another code to an internal (not external) controller.<sup>5</sup>

As noted above, because Nakamura is explicit that an indication of switching completion is merely stored internally and is not sent from the mobile to the base station, Applicants submit that Nakamura teaches away from Applicants' claimed feature of receiving a completion message from the one of a plurality of mobile stations to indicate completion of a step of switching from a first code to a second code at the one of the plurality of mobile stations. Thus, Applicants submit that any combination that modifies the internal registration of Nakamura to include the receiving a completion message from a mobile is improper.

Hamalainen only describes the sending of a time slot assignment acknowledgement message.<sup>6</sup> Hamalainen makes no reference to switching of codes or the reporting of a completed code switching. Applicants submit that equating the time slot assignment acknowledgement message of Hamalainen with Applicants' claimed code switching completion message is an improper hindsight reconstruction of Applicants' claimed

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<sup>5</sup> Nakamura column 7, lines 4-15.

<sup>6</sup> Hamalainen column 7, lines 20-26.

invention. Thus, assuming *arguendo* that the combination Nakamura and Hamalainen is proper, the combination of Nakamura and Hamalainen does not disclose or suggest Applicants' claimed feature of sending a code switching completion message from a mobile to a base station or a base station controlling apparatus.

Furthermore, like Nakamura, Hamalainen does not disclose or suggest Applicants' claimed base station controlling apparatus. That is, Hamalainen only discloses a base station and a mobile station. Hamalainen does not disclose or suggest a base station controlling apparatus separate from a plurality of base stations, as recited in Applicants' claims.

The preceding comments are primarily directed to elements recited in new Claim 7. Applicants submit that Claims 4, 6, and 8 distinguish over the previously discussed references for substantially the same reasons.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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